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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/910,653 | 07/19/2001 | Daniel E. E. Hayes JR. | HAYES-4 | 2622 |

7590

11/04/2003

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| EXAMINER |
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PELLEGRINO, BRIAN E

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| ART UNIT | PAPER NUMBER |
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3738

DATE MAILED: 11/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,653

Applicant(s)

HAYES ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/8/03 has been entered.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3,6-8,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez et al. (5938702) in view of Shetty et al. (5323954). Lopez discloses (Fig. 1) an acetabular component having a metal base **12** of two different metals, the first metal is a titanium coating **29**, col. 4, lines 20-21, and the second metal is a titanium *alloy* (col. 2, lines 4-6). Fig. 2 shows a second construct **60** made of polyethylene, col. 4, lines 60,61. With respect to claim 6, Lopez discloses the first metal enhances bone ingrowth, col. 4, lines 21-23. However, Lopez fails to disclose two different primary constituents for the different metals. Shetty et al. teach that a titanium coating can be applied on the bearing surface of an implant device having a different primary constituent such as cobalt alloy, col. 3, lines 48,49,53-60. Shetty also teaches the coating provides a corrosion resistant surface, col. 2, lines 16-20. It would have been obvious to one of

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ordinary skill in the art to use a different primary constituent such as CoCrMo for the second metal as taught by Shetty in the acetabular shell of Lopez et al. in order to provide a more corrosive resistant implant.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez '702 in view of Shetty '954 as applied to claim 1 above, and further in view of Metzger et al. (6280476). Lopez et al. in view of Shetty et al. is explained supra. However, Lopez as modified by Shetty does not disclose the first metal or the metal contacting the bone as being made of tantalum. Metzger et al. teach that a porous tantalum coating is applied to a metal shell, col. 11, lines 10-13. It would have been obvious to one of ordinary skill in the art to substitute tantalum as the porous coating as taught by Metzger with the acetabular implant of Lopez as modified by Shetty in order to provide more radiopaque prosthesis.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez '702 in view of Shetty '954 as applied to claim 1 above, and further in view of Thull et al. (5074881). Lopez et al. in view of Shetty et al. is explained supra. However, Lopez as modified by Shetty does not disclose the first metal or the metal contacting the bone as being made of tantalum alloy. Thull et al. teach that a tantalum alloy coating is applied to a metal shell to roughen and improve tissue ingrowth capabilities to the surface of the implant, col. 5, lines 40-62. It would have been obvious to one of ordinary skill in the art to substitute tantalum alloys as the coating taught by Thull with the acetabular implant of Lopez as modified by Shetty in order to provide a roughened surface and a good tissue ingrowth surface.

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Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lopez '702 in view of Shetty '954 as applied to claim 1 above, and further in view of Bateman et al. (5879404). Lopez et al. in view of Shetty et al. is explained supra. However, Lopez as modified by Shetty do not disclose the second metal or the metal contacting the inner liner is made of steel or zirconium alloys. Bateman teaches the use of metal and polyethylene components for parts of the prosthesis, col. 5, lines 18-21. Bateman also teaches that metals such as steel and zirconium alloys are used in making an acetabular component, col. 3, lines 7-11. It would have been obvious to one of ordinary skill in the art to substitute steel or zirconium alloys as taught by Bateman in the implant of Lopez as modified by Shetty in order to provide a harder metal base for greater strength.

Response to Arguments

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

TC 3700, AU 3738

Brian E. Pellegrino

